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| 10/806,191 | 03/23/2004 | Bernd Bartenbach | 54396 | 2016 |
| 26474 7590 12/03/2008 NOVAK DRUCE DELUCA + QUIGG LLP 1300 EYE STREET NW SUITE 1000 WEST TOWER WASHINGTON, DC 20005 | | | EXAMINER BOYER, RANDY | |
| | | | ART UNIT 1797 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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Mailed: 12-03-08

In re application of

Bartenbach et al.

Serial No. 10/806,191

Filed: March 3, 2004

For: PROCESS FOR CARRYING OUT A HIGH-
TEMPERATURE REACTION, REACTOR FOR
CARRYING OUT THE PROCESS, PROCESS
FOR THE SCALE-UP OF A REACTOR, AND
USE

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 to withdraw finality of the office action mailed September 5, 2008.

On January 9, 2007, a first office action was mailed to applicants, containing various grounds of rejection. Applicants responded to this office action with a response filed on November 9, 2007. A final rejection was then mailed September 5, 2008.

On September 25, 2008, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the September 5, 2008 office action.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection applied in the final office action were not necessitated by Applicant's amendments to the claims.

DECISION

Section 706.07(a) of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice. Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in

Art Unit:

an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that because Toombs (US 6,349,678) is a newly cited reference used to reject a limitation in claim 21 that was previously rejected with another reference (i.e. Gravley (US 4,765,964), the new grounds of rejection were not necessitated by Applicant's amendments to the claims. Note that the limitation of claim 21 comes from previously rejected claim 20. Claim 20 was divided into claims 20 and 21. This argument is persuasive. Therefore, the new ground of rejection over claim 21 was not necessitated by Applicant's amendment.

Because the rejection of claim 21 over newly cited prior art was not necessitated by Applicant's amendments to the claims, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

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